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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,013	10/07/2003	Michael Furst	FURST, M-2	4715
25889	7590	10/04/2005	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			TRAN, THAO T	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,013

Applicant(s)

FURST, MICHAEL

Examiner

Thao T. Tran

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13, 15-31 is/are pending in the application.
- 4a) Of the above claim(s) 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13 and 15-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/2005 has been entered.
2. Claims 1, 3-13, and 15-31 are currently pending in this application. Claims 26-31 have been newly added. Claims 1 and 12-13 have been amended.

Election/Restrictions

3. Newly submitted claims 27-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly added claims 27-31 are directed to a method of use, whereas original claims 1, 3-13, and 15-25 are directed to a film.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-31 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Claims 1, 3-13, and 15-26 are being examined together below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3-13, 15-24, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitation, “whereby the second film layer faces towards a substrate to be covered with the multilayer film”, which has no adequate support in the specification as originally presented. The specification, in paragraph 0007, presents “a film combination can be created as a result that either detaches from or presses itself onto a substrate when it is heated”. But there is nowhere in the specification that would present the second film layer faces towards a substrate.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1, 3-13, 15-24, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 is indefinite due to the use of "the second film layer faces towards a substrate". It is unclear to the examiner what Applicants are trying to convey. If Applicants mean to indicate that the second film layer is next to the substrate, please state so.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 3-13, 15-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17, 22-31 of copending Application No. 10/680,012. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims of the copending application is broader than that of the instant claims, rendering them obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The claims of the copending application disclose all of the limitations as recited in the instant claims. However, the limitations recited in instant claim 1 are disclosed in claims 1-2, 25.

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Thus, the scope of claim 1 of the copending application encompasses that of instant claim 1, rendering them obvious over each other.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3, 8, 10-13, 15, and 17-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Stierli (US Pat. 4,442,148).

Stierli discloses a laminate of structural surfaces, the laminate comprising a support sheet 3 covering at least one major surface of a self-adhesive bituminous membrane 1, an oil-impermeable polymeric coating 2 provided between the support sheet and the bituminous membrane, and a removable siliconized protective layer 4 (see abstract; Fig. 1; paragraph crossing col. 2 & 3).

The support sheet 3 comprises a polyolefin, such as an oriented polyethylene layer. The oil impermeable layer 2 comprises polyacrylonitrile. And the bituminous membrane 1 comprises a rubber or other elastomer polymer, such as polyethylene or the like, and mineral oil (see col. 3, ln. 10-24, 63-67; col. 3, ln. 6-11).

With respect to the thermal expansion, since Stierli discloses the same laminate with the same chemical components as presently claimed, the laminate of Stierli would inherently have the same physical and chemical properties, such as thermal expansion and elongation.

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With respect to how the laminate is formed, it has been well settled in the art that it is the structural elements, and not how it is made, would impart patentability when an article claim is being considered.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4-7, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stierli as applied to claims 1 and 10 above, and further in view of Bochow et al. (US Pat. 5,449,552).

Stierli is as set forth in claims 1 and 10 above and incorporated herein.

Stierli does teach the bituminous layer comprising a rubber or other elastomer polymer, such as polyethylene or the like. However, Stierli does not teach a layer comprising polypropylene, polyamide, polyethylene terephthalate, or a mixture thereof.

Bochow discloses a laminate, comprising a surface layer A, an adhesive or coupling layer B, a gas barrier layer C, another adhesive layer B, a heat sealing layer D; wherein layers A and C can be interchangeable (see abstract). The gas barrier film is oriented (stretched), comprises polyamide, polypropylene, polyethylene terephthalate, and is provided with a barrier layer of lacquer (see col. 2, ln. 3-13).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed polypropylene, polyamide, polyethylene terephthalate, or a mixture thereof, or lacquer, as taught by Bochow, in the barrier layer Stierli. Since both Stierli and Bochow disclose that these thermoplastic compounds are alternative of each other and the use of these compounds would have given the same results.

Response to Arguments

15. Applicant's arguments with respect to the rejection of the claims have been considered but are moot in view of the new ground(s) of rejection.

Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
September 30, 2005


THAO T. TRAN
PATENT EXAMINER